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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,231	12/24/2001	Charles W. Scouten	CT-DST-I	5266
7590	08/04/2005			
Patrick D. Kelly 11939 Manchester # 403 St. Louis, MD 63131			EXAMINER WEBB, SARAH K	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 08/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/036,231	Applicant(s) SCOUTEN ET AL.	
	Examiner Sarah K. Webb	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-8,10-19, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,258,103 to Saracione in view of US Patent No. 6,416,520 to Kynast et al. and further in view of US Patent No. 4,819,195 to Bell et al.

Applicant points out in pages 2-3 of the reply filed 8/31/04 that the only difference between the Saracione device and the claimed invention is that Saracione fails to display all three signals from the reader heads on one display device that is not mounted on the manipulator. The Saracione device is considered to meet the limitation "*retrofitted onto a conventional stereotaxic holder*", because the reader heads are manufactured separately and the base plate is considered to be "conventional."

In lines 32-53 of column 11, Saracione describes the reader heads as being electronic digital scales that display a measured position, have greater resolution, and have the capability of being set to zero. Saracione gives several examples of digital scales that can be utilized with the stereotaxic device: (1) the Mitutoyo scale uses capacitance and has a resolution of 0.5 microns; (2) the Anilam DRO that measures by optoelectronic scanning and has resolution less than 5 microns. (product information provided by websites www.anilam.com and www.mitutoyo.com)

As mentioned above, the only deficiency of Saracione is in the display of the signals. Kynast discloses a stereotaxic frame that has a moveable instrument connected to the frame for performing a surgical operation. The change in position of the instrument is measured by a linear translation device 110 (column 4, line 44 to

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column 5, line 80). Kynast teaches that the signal from the measuring device 110 can be visually displayed on a display element 124 separate from and moveable to the measuring device, such as a computer, CRT, flat screen LCD, or other analog or digital display. Bell discloses another device (12) that manipulates a probe (14) in three dimensions. Bell utilizes reader heads associated with each axis to take measurements, which are then transferred to a digital display (18) that shows the position of the tool along each axis independently (column 2, lines 42-47 and column 4, lines 10-21). Since it was known in the art at the time the invention was made to use a digital display device that has a location separate from the manipulator and reader heads, it would have been obvious to one of ordinary skill to connect the reader heads of the Saracione device to a separate display device.

Regarding claims 11,12,21, and 22: the device only needs to be capable of allowing these functions. The modified device of Saracione is capable of allowing continuous observation and video monitoring of a procedure.

Response to Arguments

2. The correcting drawing figure and abstract were not received by the office.
3. Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive. Applicant provides lengthy arguments and affidavits drawn to the general non-obviousness of the claimed invention. Applicant argues that because other companies tried to copy applicants' invention and failed, the claimed invention is non-obvious. This argument is not found persuasive, because the companies referenced by applicant in these arguments have nothing to do with the prior art used in the rejections.

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Applicant argues that the manipulator system of Saracione is not retrofitted onto a base plate of a conventional non-digital stereotaxic holder. Examiner considers the Saracione base plate to be conventional. Also, applicant has previously pointed out in pages 2-3 of the reply filed 8/31/04 that the only difference between the Saracione device and the claimed invention is that Saracione fails to display all three signals from the reader heads on one display device that is not mounted on the manipulator. Applicant did not state that the Saracione base plate was not conventional. This issue was addressed in the prior office action, but not subsequently addressed by applicant in the arguments filed 5/9/05. Also, the reader heads of the Saracione device are manufactured separately, so they are capable of being retrofitted onto another base plate.

Response to Amendment

4. The affidavits under 37 CFR 1.132 filed 5/9/05 are insufficient to overcome the rejection of claims 1-8, 10-19, and 21-26 based upon Saracione, Kynast, and Bell under 103, as set forth in the last Office action because: the affidavits do not address the specific deficiencies of combination of the Saracione, Kynast, and Bell. The affidavits simply assert that the claimed invention is non-obvious and unpatentable because two companies attempted to copy the design of applicants' invention. While the information provided in the affidavits was given due consideration, the general assertions of non-obviousness do not overcome the 103 rejection. The failure of these two companies to copy applicants' product does not preclude the success of another company of manufacturing a device that meets the claim limitations.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K. Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW

7/13/05

SKW
Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER